

REMARKS

Claims 1-38 were pending the application. Claims 18-38 have been canceled, without prejudice, as being directed to a non-elected invention. Claims 1-17 have also been canceled and new claims 39-62 have been added. Accordingly, upon entry of this amendment, claims 39-62 will be pending. For the Examiner's convenience, the pending claims are set forth in Appendix A.

Support for new claims 39-62 may be found throughout the specification, including the originally filed claims.

No new matter has been added. Any amendments to and/or cancellation of the claims should in no way be construed as an acquiescence to any of the Examiner's rejections and was done solely to more particularly point out and distinctly claim the subject matter of Applicants' invention in order to expedite the prosecution of the application. Applicants reserves the right to pursue the claims as originally filed in this or a separate application(s).

Supplemental Copies of Appendices

Per the Examiner's request at page 9 of the instant Restriction Requirement, Applicants submit herewith supplemental copies of Appendix A (535 pages) and Appendix B (162 pages). Supplemental copies of Appendices A and B are identical to originally filed Appendices A and B. *No new matter has been added.*

Election/Restriction

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

Group I: Claims 1-2 and 8-16, drawn to an isolated nucleic acid encoding an MCP protein, and a vector and host cell comprising the nucleic acid, classified in class 536, subclass 23.7;

Group II: Claims 3 and 6-8, drawn to an isolated nucleic acid from Appendix A, classified in class 536, subclass 23.7;

Group III: Claims 4-5 and 8, drawn to an isolated nucleic acid encoding a peptide from Appendix B, classified in class 536, subclass 23.7;

Group IV: Claim 17, drawn to a method of producing a polypeptide, classified in class 435, subclass 69.1;

Group V: Claims 18-19 and 22, drawn to an isolated MCP polypeptide, classified in class 530, subclass 350;

Group VI: Claims 20-21 and 24, drawn to an isolated polypeptide from Appendix B, classified in class 530, subclass 350;

Group VII: Claim 23, drawn to an isolated polypeptide encoded by a polynucleotide from Appendix A, classified in class 530, subclass 350;

Group VIII: Claims 25-34, drawn to a method of producing a fine chemical, classified in class 435, subclass 41;

Group IX: Claim 35, drawn to a method of detecting *Corynebacterium diphtheriae*, classified in class 435, subclass 6; and

Group X: Claims 36-38, drawn to a host cell comprising a disrupted or modified nucleic acid from Appendix A, classified in class 536, subclass 23.7.

Applicants hereby elect Group I (claims 1-2 and 8-16), *with traverse*, under 35 U.S.C. §121 for prosecution in the present application. Applicants respectfully submit that Groups I, II, III, and IV should be re-grouped together into a single Group containing claims 1-17. Applicants grounds for traversal are set forth below.

The Examiner states that

[i]nventions I-III are not related. Although all of Groups I-III recited isolated nucleic acids, the nucleic acids of Group I are not limited to be the same of those in Groups II or III; nor are the nucleic acids of Group II limited to be the same as those of Group III. Each nucleic acid sequence is a separate and distinct structure; each structure is considered an independent invention. As each of Groups I-III recite different sequences/products, the Groups are not related.

Applicants respectfully submit that claims 1 and 2 and 8-16 (Group I) were directed to isolated nucleic acid molecules from *Corynebacterium glutamicum* which encode an MPC protein or portion thereof. Claims 3 and 6-8 (Group II) were directed to isolated *Corynebacterium glutamicum* nucleic acid molecules selected from those nucleic acid molecules included in Appendix A, or a portion thereof. Claims 4, 5 and 8 (Group III) were directed to isolated nucleic acid molecules which encode a polypeptide sequence selected from Appendix B, or a portion thereof. Claims 1-17 have been cancelled. New claims 39-53 no longer refer to Table 1 or Appendices A or B. Rather, these claims recite specific SEQ ID NOs.

Applicants respectfully submit that the isolated nucleic acid molecules of Groups I-III, do not constitute independent and distinct inventions. In fact, the isolated nucleic acid molecules included in Table 1 are the same as those included in Appendix A, and encode the nucleic acid molecules included in Appendix B. For example, SEQ ID NO:1, which is listed in Table 1 as Identification Code RXN01638, and identified as encoding SEQ ID NO:2, is also included in Appendix A. The polypeptide encoded by SEQ ID NO:1 (*i.e.*, SEQ ID NO:2) is included in Appendix B. Contrary to the Examiner's assertions, the nucleic acids of Group I are limited to be the same as those in Groups II and III, and the nucleic acids of Group II are limited to be the same as those of Group III. Each of Groups I-III do not recite different sequence/products.

Furthermore, Applicants respectfully submit that Groups I-III should further be re-grouped to include the claim of Group IV. Claim 17 has been cancelled. However, new claim 62 is directed to a method of producing a polypeptide comprising culturing a host cell transfected with a vector comprising the nucleic acid molecule of any one of claims 39-42. The method of Group IV recites use of the nucleic acids of Groups I-III. That is, the method of claim 62 is limited to the use of the nucleic acids of Groups I-III (which should be combined into one Group). Accordingly, Group IV should be re-grouped into a single Group containing Groups I-IV.

Since these claims encompass the same isolated nucleic acid molecules and products, a search of the isolated nucleic acids of Groups I-III and the method of Group IV would be co-extensive and would not involve a serious burden on the Examiner.

Furthermore, Groups I, II, and III are included in the same class and subclass.

Accordingly, based on the statements set forth above, Applicants respectfully request that the Examiner re-group Groups I-III and IV together into one Group.

Requirement for Election of Species

The Examiner has further required the election of “a single disclosed fine chemical for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.” The Examiner further states that “[c]urrently, claims 1-15, 25-30 and 34 are generic.”

Applicants hereby further elect the species of “organic acids” in claim 60, for search purposes only. Applicants understand that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent from or otherwise include all the limitations of an allowed generic claims as provided by 37 C.F.R. §1.41 *et seq.* Applicants submit that new claims 39-60 and 62 are generic.

Sequence Election Requirement

In the instant Restriction Requirement, the Examiner states that

Each Group detailed above reads on patentably distinct Groups drawn to multiple SEQ ID Numbers. The sequences are patentably distinct because they are unrelated sequences and each unrelated sequence is considered a separate and distinct product therefore a further restriction is applied to each Group. For an elected Group drawn to either amino acid or polypeptide sequences, the applicant must further elect a single amino acid or a single polypeptide sequence. (See MPEP 803.04). Due to the increasingly large size of sequence databases which must be searched and the increasing numbers of applications requiring sequence searches, it creates an undue burden on the Office to search more than a single sequence (product) per application. For these reasons, the requirements of 37 CFR 1.141 *et seq.* are no longer waived and applicant is required to elect a single sequence for examination.

Applicants hereby elect SEQ ID NO:1, *with traverse*. Applicants respectfully submit that the policy set forth in 1192 O.G. 68 (Nov. 19, 1996), which the Examiner references, clearly provides that a ***reasonable number*** of sequences are allowed to be claimed in a single application. It has been determined that “normally ten sequences constitute a reasonable number for examination purposes” and, thus, up to ten independent and distinct sequences are often examined in a single application without restriction. M.P.E.P. §804.4 and 1192 O.G. 68 (Nov. 19, 1996). In the interest of saving considerable time and cost to Applicants and the United States Patent and Trademark Office, and in accordance with 1192 O.G. 68 (Nov. 19, 1996), Applicants respectfully request that at least 10 sequences be examined in the instant application.

Furthermore, it is the Applicants’ position that, with respect to the claimed nucleotide sequences, a species election for searching purposes would be more appropriate in this situation.

Applicants respectfully submit that a sufficient search and examination with respect to the claimed nucleotide sequences can be made without serious burden on the Examiner. As the M.P.E.P. states:

[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. M.P.E.P. § 803.

Applicants respectfully submit that the searches with regard to each SEQ ID NO. would be co-extensive and would not involve a serious burden on the Examiner. Applicants therefore request that the Examiner re-characterize the restriction requirement with respect to the SEQ ID NOs. as a species election requirement.

It is the Applicants’ understanding that under 35 U.S.C. §121, an election of a single species for prosecution on the merits is required, to which the claims will be restricted if no generic claim is finally held allowable. Applicants submits that claim 1 is generic. Applicants further understand that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are

written in dependent from or otherwise include all the limitations of an allowed generic claims as provided by 37 C.F.R. §1.41 *et seq.*

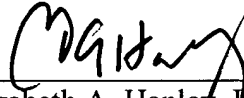
Accordingly, within Group I, Applicants hereby further elect the species of SEQ ID NO:1, SEQ ID NO:7, SEQ ID NO:13, SEQ ID NO:17, SEQ ID NO:21, SEQ ID NO:25, SEQ ID NO:29, SEQ ID NO:33, SEQ ID NO:37, and SEQ ID NO:41 for search purposes only. Applicants even further elect the species of SEQ ID NO:1 for search purposes only.

Applicants reserve the right to traverse the above restriction with respect to non-elected Groups II-X in this or subsequent applications.

SUMMARY

If a telephone conversation with Applicants' Attorney would expedite the prosecution of the above-identified application, the examiner is urged to call the undersigned at (617) 227-7400.

Respectfully submitted,



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